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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,314	09/08/2003	Vincent Bodart	403162000301	2160
25225	7590	07/14/2004		EXAMINER
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332			ZALUKAEVA, TATYANA	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/658,314	BODART, VINCENT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tatyana Zalukaeva	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 15-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 15-33 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/2003.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date.       .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other:       .

## DETAILED ACTION

1. Applicant is reminded to update the continuity data.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 15-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,258,906. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims call for absolutely identical process with that of claims 1-5 of U.S. Patent '906. The steps of both processes are absolutely identical. The word "two-stage process" in preamble ands the words "first stage" and "second stage" do not change the steps and identical stages with identical; sequence of such stages in both processes, while the instant claims call for the process that can be

performed both in one stage or two stages, having however, all the same steps of the process.

Claims 15-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,258,906. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

It is noted that during the prosecution of the patent Applications no restriction was made between the process of making dialkyl peroxydicarbonates by a two-stage process or by a process as instantly claimed.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 15-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez (U.S. 5,548,046) in view of Busseret (U.S. 3,849,468).

Sanchez discloses a method for making of dialkyl peroxydicarbonate comprising Reaction Step—A, wherein substantially pure alkyl chloroformate, or a mixture of substantially pure alkyl chloroformate, (1.8 to 2.2 moles, preferably 1.9 to 2.1 moles per mole of hydrogen peroxide) is rapidly reacted with an aqueous solution of hydrogen peroxide (1.0 mole per mole of hydrogen peroxide) and sodium hydroxide or potassium hydroxide (1.9 to 2.6, preferably 2.0 to 2.2 moles per mole of hydrogen peroxide). (col. 6, lines 25-35), then to the crude dialkyl peroxydicarbonate from step b) is added a saturated aqueous salt solution (i.e., a saturated salt solution derived from ammonium, sodium and potassium chlorides, sulfates and phosphates, preferably sodium chloride) at. Agitation is stopped and the reaction mass is allowed to separate into an upper organic layer and a lower aqueous layer. The aqueous layer is drawn off and discarded. Thus Sanchez anticipates clearly two steps of the process, and provides the additional step for a separation of dialkyl peroxydicarbonate by decantation.

The disclosure of Sanchez differs from the instant claims by providing different method of separation/purification.

Extraction with organic solvents is a separation method notoriously used in the field of organic chemistry for fuller separating of organic compounds from the liquid phase. Thus Busseret discloses a method of continuous preparation of alkylperoxydicarbonates, wherein the method involves the reaction step that is identical to the reaction step of Sanchez and to the reaction step of the instant claims, namely reacting of ethylchloroformate with peroxides in aqueous media to obtain the title compound.

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Busseret discloses the use of solvents to extract the alkylperoxydicarbonates, such solvents are dimethyl or dibutyl phthalate (known plasticizer for PVC), esters of fatty acids, such as alkyl adipates (see col.2, lines 21-25).

Since decantation and extraction are two known methods equally used for separation and purification of organic compounds, and since Sanchez and Busseret employ substantially identical processes for preparation of alkylperoxydicarbonates, one skilled in the art would have found obvious to utilize the solvents of Busseret for the extraction of a product in the proceeds of Sanchez in lieu of decantation in order to achieve better separation of an aqueous fraction and ensure higher purity of the alkylperoxydicarbonates.

8. Other prior art references cited in PTOL-892 show relevant processes and compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (571) 272-1115. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tatyana Zalukaeva  
Primary Examiner  
Art Unit 1713

June 23, 2004

